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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/709,930 09/09/96 GREEN

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TOWNSEND AND TOWNSEND AND CREW
TWO EMBARCADERO CENTER
EIGHTH FLOOR
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EXAMINER

GARLAND, S

ART UNIT PAPER NUMBER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 34

Application Number: 09/709,930

Filing Date: 09/09/96

Appellant(s): PHILIP S. GREEN

Mark D. Barrish
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 9/18/00.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

Art Unit: 2786

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 138 and 141 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

A substantially correct copy of claims 115, 118-126, 138, 139, 141, and 144 appears on pages 1-4 of the Appendix to the appellant's brief. The minor errors are as follows: in claim 123, line 14, " robotic ' should be -- first articulate --.

Art Unit: 2786

Only claims 138 and 141 are being appealed.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,524,180 Wang et al. 6-1996

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 138 and 141 are rejected under 35 U.S.C. 135(b) as not being made prior to one year from the date on which U.S. Patent No. 5,524,180 was granted.

U.S. Patent 5,524,180 to Wang et al. claims substantially the same subject matter as is now being claimed in claims 138 and 141. The 5,524,180 patent issued on June 4, 1996 more than a year before instant claims were first presented in the amendment of 7/14/99. The claims of U.S. Patent 5,524,180 bars the claim to substantially the same subject matter under 35 U.S.C. 135(b). See *In re McGrew* 43 USPQ2d 1633 (Federal Circuit 1997) which is particularly relevant.

Comparing instant claim 138 to claim 15 of the 5,524,180 patent, the claims are almost identical and are directed to system that allows a user to control movement of a surgical instrument, wherein the surgical instrument is coupled to a display device that displays an object, comprising:

a mechanism that moves the surgical instrument, said instrument having an original position:

Art Unit: 2786

an input device that receives a command to move the surgical instrument in a desired direction relative to the object displayed by the display device; and a controller that receives said command to move the surgical instrument in the desired direction, computes a movement of said mechanism based on said command and the original position of said mechanism so that the surgical instrument moves in the desired direction, and provides output signals to said mechanism to move said mechanism said computed movement to move the surgical instrument in the desired direction commanded by the user.

The only differences are that patent claim 15 states that the surgical instrument has a tip and that the motion is "incremental movement" instead of the more general "movement" of instant claim 138 .

Claim 15 of the patent is the same or substantially the same as claim 138 of the instant application, since a surgical instrument inherently has a tip, and the movement in claim 138 is an incremental movement, since it is based on an original position and a directional movement from that original position.

The additional limitations recited in instant claim 141 are virtually identical to the additional limitations of claim 26 of patent 5,524,180, the only differences are the use of the words controller and input device in the instant application instead of the words "control means" and "input means" in the patent claim. This difference in wording is a result of applicant's amendment in response to the objection made in paragraph 2 of the office action of 2/11/00.

Art Unit: 2786

(II) Response to Argument

Contrary to applicant's statement on pages 13-15 of the brief, the triggering event was the date the 5,524,180 was granted not the date the 5,815,640 patent was granted. The applicant simply failed to claim substantially the same subject matter as is claimed in the 5,524,180 patent within one year from the date the 5,524,180 patent was granted. Applicant as a result of this failure lost the right to claim substantially the same subject matter.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Steve R. Gable

srg
September 25, 2000

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